

REMARKS

Replying to the Office communication of March 7, 2003, reconsideration is respectfully requested of the 35 U.S.C. 103(a) rejection of claims 1-18 as merely the "obvious" use in the system of the Johnson patent 5,986,543 of, first, the concept of a "movable cellular phone and the separate control channel for a vehicle" used in the Sheffer patent 5,515,419, and secondly, the further "obvious" incorporating therein of the concept of the Hollenberg patent 6,091,956 of "transmitting location information to display on pedestrian's wireless device".

On its face, however, this piecing together and stretching of really unrelated bits and pieces of radically different-purpose patent systems--all with the hindsight of the strategy of applicant's invention--is, with respect, an untenable and legally improper use of an "obviousness"-type of ground of rejection. This is particularly so in the light of the Office concessions that the Johnson patent even "does not clearly indicate the control channel" (bottom of page 3 of Office action); that the Sheffer patent "does not clearly indicate the requesting location information, and the transmitting of the associated location data from control center to user"; and the speculation at most that it is "apparently obvious to include Hollenberg's transmitting location information...such that the system could be efficient to provide location information".

The fact is, however, that none of these references even hints at, let alone actually suggests and certainly does not disclose applicant's inventive concept or the solution of the problems he has addressed.

Unlike the cited prior art, applicant has specifically set out to provide in

"portable cellular phone voice communication and positional location data communications...a novel separation of voice and data aspects of the equipment and services (that) promises improved performance with substantially lower costs" (page 2 of specification, emphasis added)

This is accomplished by using voice communication between a portable cellular telephone user and a control center over the regular cellular voice communication path of a cellular phone network. Such voice communications involves the user, in the words of, for example, claim 1, "requesting location information services" of a network operations control center from a portable cellular telephone and is transmitted "over the cellular voice path".

Applicant then, totally uniquely as compared with the cited references, uses the cellular phone network “control channel path” (not the cellular telephone voice communication path) to send a “radio signal from the control center over the control channel path” to the user to activate the GPS receiver at the user location and to cause the GPS “transponder to transmit the processed location data”, again over the control channel path to said control center. At the control center, as further recited in claim 1, this “transmitted location data received “over the control center path” is subjected to the step of “associating the transmitted location data with the user voice call request (sent on the “cellular telephone voice path”) to the control center, and the center then sends the “location service information from the control center to the user” (specified in claim 2 as via the cellular telephone voice path).

As explained at the top of page 6 in applicant’s specification, this “novel idea of separating voice and data channels to accomplish cost economy” also results in “the reduction of the hardware costs”.

These same limitations of exemplary claim 1 are also contained in dependent claims 2-5 and claims 6 and 14-16, and in each or corresponding apparatus claims 7-11, 12 and 13, 17 and 18--clearly defining specific operational step and apparatus limitations outside the scope of the Johnson patent, and certainly not suggested in either the Sheffer or Hollenberg patents.

As recently re-iterated by the Court of Appeals for the Federal Circuit, In re Zurko, 42 USPQ 2d 1691 (Fed. Cir. 1998), it is improper under Sec. 103(a) for the USPTO to take the disclosure of a pending application and retrospectively conclude that the invention claimed in the application is “obvious” in view of prior art that does not actually teach the invention.

The Court of Appeals earlier cautioned that

“the mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification”. (In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir., 1984).

And, more recently, in In Re Rouffet, 149 F. 3d 1350, 47U.S.P.Q. 2d 1453 (Fed.Cir. 1998):

“...the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.”

And again in In Re Dembiczak, 175 F. 3d 994, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999):

“the insidious effect of a hindsight syndrome where that which only the inventor taught is used against the teacher.”

Nowhere in the Johnson patent (or in the Sheffer or Hollenberg patents) can there be found "any suggestion, teaching or motivation to combine the references" that might serve to support a proper obviousness analysis, and certainly none of these patents; individually or collectively teaches the solution of applicant's problem by applicant's claimed separating voice channel communication over the cellular telephone voice channel path from all data communication sent over the cellular network control channel path..

Reconsideration and allowance of claims 1-18, particularly as claims 1, 14 and 17 are amended to provide proper antecedent, is therefore believed to be in order and is accordingly respectfully requested.

Applicant concurs with the Office that the remaining cited patent references to Schwinke, Lewis, Timm et al, Hegdon et al and Stewart, while "pertinent", are also not anticipatory of applicant's claimed invention.

Any costs incurred by this amendment, including for required time extensions, petition for which is hereby requested, may be charged to account No.18-1425 of the undersigned attorneys.

Very Respectfully,

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